

**REMARKS**

Claims 1-25, 29-42, 44 and 45 are rejected. Claims 26-28 and 43 are withdrawn from consideration. Claims 1, 5, 9, 18 and 41 have been amended. Claims 3, 4, 5, 10, 44, and 45 have been canceled. Claims 1, 2, 6-9, 11-25, 29-42 are presently pending in the application. Favorable reconsideration of the application in view of the following remarks is respectfully requested.

The basis for the support amendment support is found on pg.12, line and pg. 18, line 16 pg. 19, line 14 of the specification as originally filed. The basis for the remaining amendments to claim 1 is found in claims 3 and 4 as originally filed, as well as Table 4 on pg. 25 of the specification as originally filed. The amendments of claims 5, 9, 18, and 41 are these same claims as originally filed modified with respect to dependency.

The following remarks summarize the key points made in the Amendment mailed by applicant on December 17, 2004.

**Rejection Of Claims 1-25, 29-42, 44 and 45 Under 35 U.S.C. §103(a):**

The Examiner has rejected Claims 1-25, 29-42, 44 and 45 under 35 U.S.C. 103(a) as being unpatentable over Maeda et al. (Japanese Kokai Patent Application No. Hei 7[1995]137432.

Maeda fails to mention the use of particles of mean diameter less than 0.5 micrometers and fails to mention the use of these particles to enhance the gloss of a coated layer. In fact, the particle size range of the particles of Maeda range from 0.5-100 micrometers and Maeda teaches that, if the particle size is too small, the particles become difficult to handle in a coating material. See paragraph [0006] of Maeda. Maeda also fails to produce a reasonable expectation of success, as Maeda fails to mention that particles of size less than 0.5 micrometers prove useful in providing a coating with increased gloss (paragraph [0026] of Maeda) and also teaches that these particles are difficult to handle in coating materials (see paragraph [0006]). Finally, Maeda fails to teach all of the limitations of the present claims as it fails to teach or disclose the use of particles of less than 0.5 micrometers. Maeda fails to mention that in a distribution of particles of mean diameter less than 0.5 microns, more than 68% have a particle size of less than 0.5 microns to produce high gloss coatings. See paragraph [0006], [0020], and [0021] of Maeda. As a result, Maeda fails to support a prima facie case of obviousness under 35 U.S.C. 103(a).

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Even assuming such a case is made, the reference to Maeda teaches away from the present invention by indicating in [0006] that smaller particles are difficult to handle as coating additives. In addition, the present invention provides a surprising result of increased gloss when the particles are used as an additive in a coating, as illustrated by Elements 1, 2, and 5 in Table 5 on page 26 of the specification, at proportions of 68% or greater. See also Maeda [0024] which states that "If the average particle size of the hollow porous resin particles that form the absorbing layer is smaller than 1  $\mu\text{m}$ , there is almost no absorbing affect. Data Table 5 on pg. 28 of the present specification indicates the opposite, in fact, as the coatings containing particle of less than mean particle diameter of 0.5 had a shorter ink dry time, which is related to absorhency, than the control (particle size of 1-3 microns).

The following Table has been prepared to further clarify the results obtainable with the inventive particles as discussed in detail in the Third Declaration of Landry-Coltrain provided in the previous office action.

**Table 12**

	%total particles having diameter less than 0.5 microns	60° gloss
PE-1	68%	23, 30
PE-2	More than 68%	65, 48
PE-3	Less than 38%	3
PE-4	Less than 51%	10

The Table indicates that at least a 4 fold increase in 60° gloss is achieved when more than 68% of the particles have a particle diameter of less than 0.5 microns. If larger particles are present, by subtraction, they would account for no more than 32% of the particles. The Examiner states that "The mere fact that Maeda et al. does not discuss gloss does not overcome the rejection. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985)." However, according to Maeda, not only are the particles greater than 0.5 in mean diameter, but the

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particles of this size occupy more than 70 weight % of the total. See Maeda, paragraph [0006]. The present claims are limited at least 68% of particles with a diameter of less than 0.5 microns.

The Examiner states that the results in the specification are for one specific material rather than the broad category of polyesters that is now claimed. The Second Declaration of Landry-Coltrain, previously provided, contains evidence of the functionality of the present invention utilizing other materials in the broad category of polyesters presently claimed.

**Rejection of Claims 1-17, 19-25, 34, 35, 38, 44 and 45 Under 35 U.S.C.**

**§102(b):**

The Examiner has rejected Claims 1-17, 19-25, 34, 35, 38, 44 and 45 under 35 U.S.C. 102(b) as being anticipated by Okumura et al. (5,360,780).

Okumura discloses an image-receiving sheet for thermal transfer printing comprising a substrate and an image-receiving layer disposed on said substrate, characterized in that said image-receiving layer contains thermoplastic resin fine particle aggregates.

A claim is anticipated under 102(b) only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. Verdegaal Bros. V. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The present invention claims an inkjet recording element comprising a support having thereon an ink receiving layer capable of accepting an inkjet image. Okumura fails to mention inkjet recording elements or ink receiving layers capable of accepting inkjet images, teaching instead thermal transfer printing elements. Therefore, the rejection should be withdrawn.

**Rejection Of Claims 1-17, 19-25, 33-39, 41, 42, 44 and 45 Under 35 U.S.C.**

**§103(a):**

Claims 1-17, 19-25, 33-39, 41, 42, 44 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumura et al. (5360780).

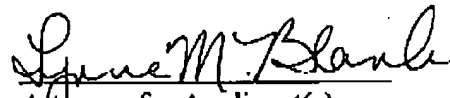
Okumura fails to mention the use of a distribution of particles of mean diameter less than 0.5 micrometers of which 68% of the particles have a diameter of less than 0.5 microns and fails to mention the use of these particles to enhance the gloss of a coated inkjet layer. In fact, Okumura teaches use of particles in a thermal transfer receiving sheet. Okumura also fails to produce a

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reasonable expectation of success, as Okumura fails to mention that particles of size less than 0.5 micrometers prove useful in increasing gloss or providing an inkjet coating with increased gloss. It would not be obvious to one of ordinary skill in the art would recognize that the materials useful in thermal transfer receiving layers would function properly in inkjet layers, let alone improve the gloss. Finally, Okumura fails to teach all of the limitations of the present claims as it fails to teach or disclose the use of particles of less than 0.5 micrometers and fails to mention that in a distribution of particles of mean diameter less than 0.5 microns, more than 68% have a particle size of less than 0.5 microns to produce high gloss coatings. As a result, Okumura fails to support a prima facie case of obviousness under 35 U.S.C. 103(a).

It is believed that the foregoing is a complete response to the Office Action and that the claims are in condition for allowance. Favorable reconsideration and early passage to issue is therefore earnestly solicited.

Respectfully submitted,

  
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